

MPEP § 2173.05(h) states the proper test: "Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims." The guidance for examination continues: "One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being 'selected from the group consisting of A, B and C.'" MPEP § 2173.05(h)(I), *citing Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925) (emphasis added). Other examples of acceptable alternative claim language published by the PTO may be found in the following sources: MPEP Appendix AI (PCT), Example 20, p. AI-44 of the July 1998 edition ("wherein R1 is methyl or phenyl, X and Z are selected from oxygen (O) and sulfur (S)."); *Training Materials For Examining Patent Applications with Respect to 35 U.S.C. Section 112, First Paragraph - Enablement Chemical/Biotechnical Applications*, released August, 1996 ("X selected from A, B, and C"). In sum, the PTO expects and allows alternative claim language other than the strict formulation "selected from the group consisting of," and provides a test for determining proper alternative claim language.

Applying the proper test to Applicants' claim language, no uncertainty or ambiguity is found. For example, in claim 2, Applicants claim that, "the at least one metallic coat is formed from at least one metal chosen from silver, nickel, chromium, molybdenum, aluminum, gold, copper, tin, and magnesium." Thus, the metal is silver, nickel, chromium, molybdenum, aluminum, gold, copper, tin, magnesium, or mixtures of any of the foregoing. Applicants find "no uncertainty or ambiguity with respect to the question of scope or clarity" of this claim language. Applicants assert that the Examiner

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

has not shown improper alternative claim language, and therefore has not shown how the claims are indefinite. Therefore, this rejection should be withdrawn.

REJECTION UNDER 35 U.S.C. §103

Claims 1-42 have been rejected under 35 U.S.C. §103(a) over JP 10158541 in view of Schmid et al. (U.S. Patent No. 5,624,486) and further in view of JP 5017710.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art references when combined must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine reference teachings. Finally, there must be a reasonable expectation of success. M.P.E.P. § 2143 (7th ed. 1998).

Applicants respectfully traverse the rejection since the Examiner has failed to establish that the combination of references teaches or suggests all the claim elements. Moreover, the Examiner has failed to establish that one of ordinary skill in the art would have been motivated to combine the references to achieve the claimed invention. In particular, the Examiner has failed to point to a teaching or suggestion in the references or the knowledge available to one of ordinary skill in the cosmetic art that would motivate one of ordinary skill in the art to make the combination proposed by the Examiner.

The Examiner relies on JP 101585541 for teaching that "the surface of a powder pigment base material composition of glass particles" can be coated "with a silver alloy." Office Action at 3. The Examiner also relies on this reference for providing the

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

motivation to use the disclosed pigments due to its "weather resistance and glittery property." Office Action at 5.

The Examiner acknowledges that this reference does not teach or suggest a cosmetically-acceptable medium. Office Action at 4. The Examiner has failed to point to a teaching or suggestion in this reference that would motivate one of ordinary skill in the art to use the disclosed pigments in a cosmetic composition with a cosmetically-acceptable medium. Moreover, the Examiner has failed to establish how the disclosed properties would motivate one of ordinary skill in the art to use the disclosed pigment in a cosmetic composition. For example, the Examiner has failed to elucidate how "weather resistance" is a property that one of ordinary skill in the cosmetic art would be interested in achieving in a cosmetic composition. Applicants respectfully submit that this reference is not in the field of Applicants' endeavor, and is not reasonably pertinent to the particular problem with which Applicants are concerned. Thus, this reference is nonanalogous art and should not be a basis for rejection. MPEP §2141.01(a).

The Examiner next relies on Schmid et al. for teaching a cosmetically-acceptable medium and refers to col. 6, lines 9-42. Office Action at 4. However, the Examiner has misread the disclosure of the solvents in Schmid. This particular disclosure teaches using organic solvents in the process for producing the multiply coated luster pigments. Col. 6, lines 1-8. Schmid then discloses "[s]uitable organic solvents for this purpose." Col. 6, line 9. The Examiner has failed to point to a teaching or suggestion in Schmid wherein the organic solvents are used with the finally produced multiply coated luster pigments in a cosmetic make-up composition. In particular, Schmid does not teach or suggest a cosmetic make-up composition comprising a cosmetically-acceptable

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

medium. Moreover, the Examiner has not pointed to any teaching or suggestion in Schmid which would motivate one of ordinary skill in the art to use the organic solvents used in the production process for later use in a cosmetic composition.

The Examiner then relies on Schmid for teaching the use of the luster pigments in cosmetics. Office Action at 4. However, there is no disclosure in Schmid that would enable one of ordinary skill in the art to make a cosmetic composition containing such pigments. The mere mention of a utility does not provide enablement to one of ordinary skill in the art, especially when the primary uses, including the examples, are directed to varnishes. Absent an enabling disclosure of how to use the luster pigments to make a cosmetic composition, Schmid is not proper prior art and should not form the basis for a rejection. Moreover, the Examiner relies on Schmid for teaching "metallic (luster) substrate pigment particles" and expressly lists the metals suitable for the substrate. *Id.* The Examiner has failed to point to a teaching or disclosure in Schmid that would motivate one of ordinary skill in the art to use glass particles coated with at least one metallic coat in a cosmetic make-up composition, as presently claimed.

Finally, the Examiner relies on JP 5017710 for teaching "film-forming polymers." Office Action at 4. However, JP 5017710 does not teach or suggest a cosmetic make-up composition comprising at least one dyestuff in a cosmetically-acceptable medium. Moreover, the Examiner has not pointed to any disclosure in this reference that would motivate one of ordinary skill in the art to use these alleged "film-forming polymers" in a cosmetic composition. Presumably, this is because the reference is directed to coatings for cars and motorcycles and for this reason is nonanalogous art. The Examiner has failed to establish how a reference directed to coatings for cars and motorcycles would

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

be useful in a cosmetic. This reference is not in the field of Applicants' endeavor or reasonably pertinent to the particular problem with which Applicants' are concerned. MPEP §2141.01(a).

In sum, Applicants acknowledge that at most JP 10158541 teaches a glass particle coated with a metallic pigment. Applicants also acknowledge that Schmid teaches that luster effect pigments may be used in cosmetics, and that organic solvents may be used in the production of luster effect pigments. However, neither of these two references teaches or suggests that the pigments disclosed in JP 10158541 should or could be used in a cosmetic composition with a cosmetically-acceptable medium. Moreover, the Examiner has failed to establish how the disclosed properties in JP 10158541 would motivate one of ordinary skill in the art to use its claimed pigment with the production organic solvents disclosed in Schmid to achieve the claimed invention. JP 5017710 does not remedy any of the deficiencies of the combination of JP 10158541 and Schmid.

Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness. Specifically, the Examiner has relied on nonanalogous art to form a rejection that is based entirely on hindsight reconstruction. The use of such references to form such a rejection is improper and should be withdrawn. Reconsideration and withdrawal of the rejection are respectfully requested.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

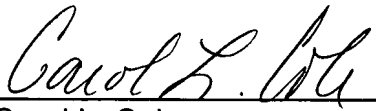
1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 15, 2002

By: 
Carol L. Cole
Reg. No. 43,555

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com